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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,372	07/05/2005	Arnold Keller	246472008200	1076

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

SCHILLINGER, ANN M

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/541,372

Applicant(s)

KELLER, ARNOLD

Examiner

Ann Schillinger

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/5/05, 3/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show where the cross-sections of Figures 7 and 8 are being taken from as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3738

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord (U.S. Pat. No. 4,623,349) in view of Andriacchi et al. (U. S. Pat. No. 4,279,042). Lord discloses the following of claim 1: a hip prosthesis, comprising a shaft (1) which is configured to be anchored in a medullary canal of a femur and has a distal portion which is configured to be anchored in a diaphysis (col. 3, lines 5-10; see Figure 10), the shaft having a core cross-section which tapers (See Figure 1) toward a distal end (4) and which has longitudinal ribs (7) on a lateral side and a medial side (as shown in Figure 1, element 7 substantially surrounds the circumference of the prosthesis) whose height increases from a proximal portion (3) of the shaft to a distal end portion of the shaft (col. 5, lines 34-38), the shaft core cross-section at a distance of 1 cm from the distal end portion being substantially rectangular, with an axis ratio of at least 1:4, and, near a distal end, having a rib on each of its two lateral edges (element 7 located on the left and right sides of the prosthesis), the height of which is on average under 2 mm (col. 5, lines 34-38), the boundary of the shaft core cross-section between the two ribs (21) located on the lateral edges not protruding further laterally from the prosthesis than the two ribs located on the lateral edges (see Figure 2). Lord does not specifically disclose the prosthesis as having a substantially rectangular geometry with the claimed axis ratio. Andriacchi et al. teaches a rectangular cross-section with a ratio greater than 1:4 in Figures 3 and 4 and in col. 3, lines 29-42, which indicate that the shape and dimensions of the prosthesis may be altered to best suit the particular patient who will be receiving the prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to adjust the shape and

Art Unit: 3738

dimensions of the prosthesis to best suit a particular femur and allow the prosthesis optimal function.

Regarding the claim language discussing the axis ratio, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use these values, since it has held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Lord discloses the following of claim 2: the prosthesis as claimed in claim 1, wherein a rib (Figure 1 shows there are parts of element 7 located at the very center of the prosthesis) provided between the two ribs located on the lateral edges that protrudes from the prosthesis by not more than 2 mm further laterally than the two ribs located on the lateral edges (col. 5, lines 34-38).

Lord discloses the following of claim 3: the prosthesis as claimed in claim 1 or 2, further comprising a rib is provided on each of the medial edges (see Figure 1 for element 7 which has parts between the very center and the lateral edges).

Lord discloses the following of claim 4: the prosthesis as claimed in claim 1 or 2, wherein a rib (Figure 1 shows there are parts of element 7 located at between the lateral edges and the outer boundaries of the center of the prosthesis) provided between a rib provided on the lateral edge and a rib located on the medial edge protrudes not more than 2 mm in a ventral or dorsal direction from the prosthesis than the ribs arranged on the lateral and medial edges (col. 5, lines 34-38).

Andriacchi et al. teaches the limitations of claim 5 in Figures 3 and 4 and in col. 3, lines 29-42.

Art Unit: 3738

Lord discloses the following of claim 6: the prosthesis as claimed in claim 1 or 2, characterized in that the ribs have roughened surfaces (col. 6, lines 53-55).

Lord discloses the following of claim 9: the prosthesis as claimed in claim 1 or 2, wherein the rib height increases from the proximal end of the distal portion to the distal end of the distal portion from less than 0.5 mm to 0.5 to 1.5 mm (col. 5, lines 34-38). The examiner is interpreting the claim language to indicate that the range may include any one of these values.

Claims 7, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord in view of Andriacchi et al. in further view of Cheal et al. (U.S. Pat. No. 6,702,854). Cheal et al. teaches in the abstract and in col. 14, lines 15-36 that it is well known in the art that there are basic standards for length and area of hip prosthetics that work for most patients and may be adjusted as necessary. Lord discloses the claimed invention except for the specific lengths and areas disclosed by the above claims. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these values, since it has held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Additionally, there is no indicated criticality for these particular claimed values in the specification. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use the known standard measurements for the prosthesis and make further adjustments as necessary for a particular patient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger
January 26, 2007

A. Stewart
ALVIN J. STEWART
PRIMARY EXAMINER